

**REMARKS/ARGUMENTS**

The Office Action mailed June 19, 2007 has been received and reviewed. Claims 1 through 58 are currently pending in the application. Claims 1 through 58 stand rejected. Claims 1, 24 and 40 have been amended herein. Applicants respectfully request reconsideration of the application in view of the current amendments.

**Information Disclosure Statement(s)**

Applicants note that the Information Disclosure Statement (IDS) submitted on July 7, 2004, is being considered by the Examiner; and specifically, that the Examiner has requested a date for the NYRA One Account reference. Applicants state that the actual publication date is unknown to Applicants and that the publication was downloaded from [www.nyra.com](http://www.nyra.com) in approximately June 2004. Applicants note that the NYRA One Account was implemented by NYRA in different embodiments prior to the filing of this application and can only verify that the embodiments described in paragraph 7 of the as-filed application were implemented by NYRA prior to the filing of this application.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on NYRA One Account ("NYRA")**

Claims 1-3, 5-10, 13-17, 20, 23-29, 31-32, 35-37, 40-44, 48-49, 51-55 and 58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by NYRA One Account ("NYRA"). As stated above, the actual publication date of the NYRA publication is unknown to Applicants. Applicants respectfully traverse this rejection, as herein set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-3, 5-10, 13-17, 20 and 23

The rejection of independent claim 1 is improper because NYRA fails to disclose “placing a cashless purchase other than a pari-mutuel wager using the house card at the establishment to debit at least another portion of the funds of the monetary account,” as recited in claim 1. Claim 1, as amended, clarifies that placing a purchase includes placing a purchase other than a pari-mutuel wager.

Additionally, the Examiner’s assertion that NYRA discloses making a purchase using a house card still fails to disclose “placing a cashless purchase,” as recited in claim 1. NYRA discloses that withdrawals may be made at the track. *See NYRA* at p. 4. Such withdrawals require the cardholder to access a Sam machine, insert a card, select an amount to be withdrawn and exit the account. *Id.* at p. 4-5. A voucher is produced by the machine and the cardholder must take the voucher to a pari-mutuel window in order to exchange the voucher for cash. *Id.* at p. 5. At that point, the cardholder may use the cash to make a purchase. Such a process requires use of cash to make the purchase and therefore fails to disclose a method including placing a cashless purchase.

Independent claim 1, therefore, distinguishes over NYRA at least by reciting “placing a cashless purchase other than a pari-mutuel wager using the house card at the establishment to debit at least another portion of the funds of the monetary account,” since these recited features are not expressly or inherently described by NYRA. Thus, applicants assert that claim 1 is not anticipated by NYRA and respectfully request that the Examiner withdraw the rejection of independent claim 1 under 35 U.S.C. § 102(b).

Applicants additionally assert that each of dependent claims 2, 3, 5-10, 13-17, 20 and 23 is allowable at least because each depends from claim 1, which is allowable. Therefore, Applicants assert that claims 2, 3, 5-10, 13-17, 20 and 23 are not anticipated by NYRA and respectfully request that the Examiner withdraw the rejection of dependent claims 2, 3, 5-10, 13-17, 20 and 23 under 35 U.S.C. § 102(b).

Regarding dependent claim 17, Applicants additionally assert that NYRA does not describe “forwarding information regarding an outcome of the pari-mutuel wager over a communication link,” as recited in dependent claim 17. NYRA only discloses the ability to retrieve information regarding, *inter alia*, race results using a telephone. *NYRA* at p. 13. Nothing in NYRA discloses

forwarding information. Instead, in NYRA the user is required to access a telephone and call the specified number to retrieve the information. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 17 under 35 U.S.C. § 102(b) for this additional reason.

Regarding dependent claim 20, Applicants additionally assert that NYRA fails to describe “selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account,” as recited in dependent claim 20. The Examiner fails to particularly recite any disclosure in NYRA relating to claim 20. Indeed, nothing in NYRA discloses a house card associated with more than one account, and, more particularly, with a monetary account associated with a debit or credit card account. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 102(b) for this additional reason.

Claims 24-29, 31, 32 and 35-37

The rejection of independent claim 24 is improper because NYRA fails to disclose “presenting a credit card or a debit card associated with a monetary account to a card reader in communication with the gaming terminal; accessing at least a portion of funds of the monetary account for use at the gaming terminal; placing a pari-mutuel wager at the gaming terminal on an event using the at least a portion of the funds; and placing a cashless purchase other than placing a pari-mutuel wager using the credit card or the debit card at the establishment to debit at least another portion of the funds of the monetary account,” as recited in claim 24. NYRA discloses the use of a house card to place a pari-mutuel bet using a Sam machine or a Tiny Tim machine. *NYRA* at p. 6-9. The card is associated with a single account that is not associated with any credit card or debit card accounts. *See Id.* at p. 1-13. Bets can only be placed by presenting the NYRA Account wagering card, as opposed to presenting a credit card or debit card. Additionally, the NYRA Account wagering card is not associated with any monetary account associated with a credit card or a debit card. This is further supported by the fact that NYRA discloses the need to call an operator, be transferred to an agent, and request a transfer from a credit or debit card account to the NYRA account. Such a disclosure would not be necessary if the house card

comprised a credit card or a debit card or was associated with the credit card or debit card account.

Independent claim 24, therefore, distinguishes over NYRA at least by reciting the features listed above, since these recited features are not expressly or inherently described by NYRA. Thus, applicants assert that claim 24 is not anticipated by NYRA and respectfully request that the Examiner withdraw the rejection of independent claim 24 under 35 U.S.C. § 102(b).

Applicants additionally assert that each of dependent claims 25-29, 31, 32 and 35-37 is allowable at least because each depends from claim 24, which is allowable. Therefore, Applicants assert that claims 25-29, 31, 32 and 35-37 are not anticipated by NYRA and respectfully request that the Examiner withdraw the rejection of dependent claims 25-29, 31, 32 and 35-37 under 35 U.S.C. § 102(b).

Regarding dependent claim 37, Applicants additionally assert that NYRA does not describe “forwarding information regarding an outcome of the pari-mutuel wager over a communication link,” as recited in dependent claim 37. NYRA only discloses the ability to retrieve information regarding, *inter alia*, race results. NYRA at p. 13. Nothing in NYRA discloses forwarding information. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 37 under 35 U.S.C. § 102(b) for this additional reason.

#### Claims 40-44, 48, 49, 51-55 and 58

The rejection of independent claim 40 is improper because NYRA fails, at least, to disclose “placing a purchase of goods or services sold at an establishment, other than a pari-mutuel wager, over the communication link using another portion of the funds,” as recited in claim 40. As discussed above, NYRA is limited to placing a pari-mutuel wager using a card and a Sam or Tiny Tim machine at a race track or, alternatively, over the phone. The user is limited to placing a wager and cannot make any purchases of goods or services using the card, and, more particularly, purchase goods or services over a communication link. Additionally, Applicants respectfully point out that the Examiner has not asserted any such disclosure in NYRA.

Independent claim 40, therefore, distinguishes over NYRA at least by reciting the features listed above, since these recited features are not expressly or inherently described by NYRA. Thus,

applicants assert that claim 40 is not anticipated by NYRA and respectfully request that the Examiner withdraw the rejection of independent claim 40 under 35 U.S.C. § 102(b).

Applicants additionally assert that each of dependent claims 41-44, 48, 49, 51-55 and 58 is allowable at least because each depends from claim 40, which is allowable. Therefore, Applicants assert that claims 41-44, 48, 49, 51-55 and 58 are not anticipated by NYRA and respectfully request that the Examiner withdraw the rejection of dependent claims 41-44, 48, 49, 51-55 and 58 under 35 U.S.C. § 102(b).

Regarding dependent claim 51, Applicants additionally assert that NYRA fails to describe “selecting the monetary account to be associated with a debit or credit card,” as recited in dependent claim 51. The Examiner fails to particularly recite any disclosure in NYRA relating the claim 51. Indeed, nothing in NYRA discloses a house card associated a debit or credit card account. Instead, a user must make a transfer from a credit or debit card by calling an operator, be transferred to an agent, and then request the transfer. *See NYRA* at p. 4. If the account were associated with a credit or debit card, such a method for transferring funds from a credit or debit card would not be necessary. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 102(b) for this additional reason.

Regarding dependent claim 55, Applicants additionally assert that NYRA fails to describe “selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account,” as recited in dependent claim 55. Nothing in NYRA discloses a house card associated with more than one account. Additionally, as discussed above, NYRA does not describe the use of a monetary account associated with a debit or credit card account. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 102(b) for this additional reason.

### **35 U.S.C. § 103(a) Obviousness Rejections**

The remaining claims are rejected under 35 U.S.C. § 103(a) as being obvious over NYRA or NYRA in combination with another disclosure.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985

(CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, and such a reason “must be made explicit” by the Examiner. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination of the references and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Indeed, underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

#### Obviousness Rejection Based on NYRA

Claims 12, 18, 19, 30, 38, 39 and 45-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA. Applicants respectfully traverse this rejection, as herein set forth.

Claims 12, 18, 19, 30, 38, 39 and 45-47 each depends from one of independent claims 1, 24 and 40. As discussed above, NYRA fails to teach or suggest each of the limitations of independent claims 1, 24 and 40. The nonobviousness of each of these independent claims precludes a rejection of claims 12, 18, 19, 30, 38, 39 and 45-47, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 12, 18, 19, 30, 38, 39 and 45-47.

Regarding claims 18, 19, 38 and 39, and as asserted above with relation to dependent claims 17 and 37, NYRA fails to teach or suggest forwarding information. Applicants respectfully disagree with the Examiner's assertion that NYRA discloses forwarding information via a telephone. The telephone system in NYRA requires that the user call the system and retrieve information. *See NYRA* at p. 13. NYRA, further fails to teach or suggest forwarding the information using text messaging or using email. Therefore, Applicants respectfully assert that

dependent claims 18, 19, 38 and 39 would not have been obvious to a person of ordinary skill in the art in view of NYRA, and request that the Examiner withdraw the rejection of dependent claims 18, 19, 38 and 39 under 35 U.S.C. § 103(a) for this additional reason.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,307,956 to Black

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Black (U.S. Patent No. 6,307,956). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 4 is dependent from claim 1 and further requires using the house card to access a secure area at the establishment. The Examiner relies on NYRA as disclosing all of the limitations of claim 1 in combination with Black. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claim 1. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 4, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,558,255 to Walker

Claims 11 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Walker (U.S. Patent No. 6,558,255). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 11 is dependent from claim 1 while claim 50 is dependent from claim 40. Claims 11 and 50 further require selecting the house card to have a predominated amount of funds. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Walker. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 11 and 50, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,379,248 to Jorasch *et al.*

Claims 21, 22, 56 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Jorasch *et al.* (U.S. Patent No. 6,379,248). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 21 and 22 depend indirectly from claim 1 while claims 56 and 57 depend indirectly from claim 40. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Jorasch *et al.* As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 21, 22, 56 and 57, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,547,131 to Foodman

Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Foodman (U.S. Patent No. 6,547,131). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 33 and 34 depend indirectly from claim 24. The Examiner relies on NYRA as disclosing all of the limitations of claim 24 in combination with Foodman as disclosing the limitations in claims 33 and 34. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 24. Therefore, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 33 and 34, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.



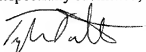
### ENTRY OF AMENDMENTS

The amendments to claims 1, 24 and 40 should be entered by the Examiner because the amendments are supported by the as-filed specification.

### CONCLUSION

Claims 1 through 58 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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